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Attorney Dock # 5300-16

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Neil S. CASA et al.

Serial No.: 10/007,484

Filed: November 7, 2001

For: Vibration-Isolating Coupling Including An
Elastomer Diaphragm For Scanning Electron
Microscope And The Like

Examiner: Hashmi, Zia R.
Group Art: 2881

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Name of applicant, assignee or Registered Representative

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Signature

January 25, 2005

Date of Signature

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RESPONSE TO RESTRICTION REQUIREMENT

SIR:

This is in response to the Restriction Requirement dated December 10, 2004. It is noted that a three-month shortened statutory period for response has been set by the Examiner expiring March 10, 2005.

Applicants hereby elect claims 1-30 of Group I, with traverse.

Applicants traverse the Restriction Requirement for the following reasons.

The Examiner contends that "Inventions I and II are unrelated." This is incorrect.

Claim 1 is a sub-combination of claim 31. Likewise, claim 19 is a sub-combination of claim 32.

Thus, Inventions I and II are related. The Examiner's attention is directed to MPEP 802.01 which discusses combination/sub-combination claims as being dependent (as opposed to "independent") and related, with the term "related" being "used as an alternative for dependent in referring to subjects other than independent subjects."

The Examiner further states the following:

"Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP 806.04, MPEP 808.01)".

The Examiner points to MPEP 806.04 in connection with the above-quoted statement. However, it is respectfully submitted that no part of this section includes the wording quoted by the Examiner, nor is any part of section 806.04 appropriate to the present combination/sub-combination claims.

MPEP §808.01 applies to independent inventions. As established above, the present situation involves dependent inventions. Thus, this section of the MPEP is also not applicable to the present situation.

Since restriction is proper for dependent inventions only if they are "distinct", the Examiner must establish that such distinctness exists. In this regard, the Examiner points to different classification, and also states the following:

"With respect to Invention I, the coupling device is placed between first and second chambers for preventing transfer of vibrations between chambers and for sealing a passage between the first and second chambers."

"With respect to Invention II, the metrology system for inspecting wafers comprising a floating inspection chamber under vacuum, a fixed transfer chamber, a gate valve arranged between the chambers, and a coupling to prevent vibrations transfer."

However, it is respectfully pointed out that the above-quoted portion of the restriction requirement is a mere recitation of claimed features rather than a presentation of reasoning in support of the restriction requirement. The criteria for establishing distinctness in a combination/sub-combination situation such as the one at hand is set forth in MPEP 806.05(c), which states the following:

"In order to establish that combination and sub-combination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP 808.02.

Inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the sub-combination as claimed for patentability... , and

(B) the sub-combination can be shown to have utility either by itself or in other indifferent relations.

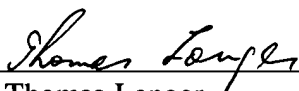
When these factors cannot be shown, such inventions are not distinct." (emphasis added)

This section goes on to discuss sub-combinations not essential to combination, and sub-combinations essential to combination. If "the separately claimed sub-combination... constitutes the essential distinguishing feature of the combination... as claimed, the inventions are not

distinct and a requirement for restriction must be not be made, even though the sub-combination has separate utility." It is respectfully submitted that the essential distinguishing feature of the claimed combination is the claimed sub-combination. Accordingly, the restriction requirement is not proper and "must not be made." Thus, its withdrawal is respectfully solicited.

Any additional fees or charges required at this time in connection with the application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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